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| 10/727,303 | 12/02/2003 | Paul Gallagher | 12729-102 | 5215 |
| 56020 7590 04/06/2007 BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE P.O. BOX 10395 CHICAGO, IL 60610 | | | EXAMINER BORLINGHAUS, JASON M | |
| | | | ART UNIT 3693 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/12/06 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 3, 6 – 8, 11, 23 – 25, 28 – 29, 36 – 42 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 1, 6, 23, 28 and 36, Examiner, after consulting additional examiners, would like to suggest that claim language be added concerning what steps or processes are being performed by a third-party or an intermediary between the first user (payor) and second user (recipient), as claim language currently makes such unclear.

Claims also recite conditional language ("if" statements) without sufficiently providing one of ordinary skill instructions for proceeding in the event

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at least one of the conditions fails. Such Claim is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Furthermore, the Claim is extremely broad as it is silent regarding what will be done if the condition fails, hence giving the claims their broadest reasonable interpretation; a reasonable alternative is to do nothing. Note also that this rationale applies to subsequent dependent claims that depend from this initial conditional statement, and/or contain a conditional limitation as language.

Additionally, in regards to Claim 6, claim language states:

automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that funds are ready for transfer to the recipient;

There is no mention of the query requesting identity confirmation being sent to the recipient, although later steps have the recipient responding to the query.

Claim 6 also states:

receiving a response from the recipient accepting or rejecting the transfer of funds wherein the response from the recipient includes identity information and an answer to the query responsive to the request for identity confirmation if the recipient accepts the transfer;

The recipient responds with identity information and identity confirmation information responsive to the query? Are these informational items the same or different? Or does is the system just being redundant? Does the conditional "if the recipient accepts the transfer" clause apply to the identity information, identity confirmation information or both?

Claim 6 states:

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automatically sending the identity information to the first user;

The identity information or the identity confirmation information? Does the system automatically send the information to the first user or is it actually conditional upon his acceptance of the transfer? Assumedly, if the recipient rejects the funds there is no need for the transmission of identity information to the first user.

Claims 23, 28 and 36 have similar issues to those currently cited.

Dependent claims are rejected based upon their dependency to rejected independent claims.

Regarding Claim 37, Examiner requests that Applicant spell out the abbreviation "ACA transaction," as Examiner could not locate ACA in the specification and multiple possible banking/finance interpretations of such term was retrieved via a prior art search.

Please examine all claims and, where required, correct appropriately.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 3, 6 – 8, 11, 23 – 25, 28 – 29, 36 – 42 and 48 are rejected under 35 U.S.C. 103(a) as being anticipated by Barbara (PG Pub 2002/0016769) in view of Ewing (PG Pub. 2002/0095298), Official Notice and Ito (US Patent 6,039,250).

Regarding Claims 1 – 3, 8 and 11, Barbara discloses a computer implemented method of transferring funds from an online account associated with a first user (customer transaction account) to a recipient online account (recipient transaction account) (see fig.1), the method comprising:

- receiving a transfer request from the first user (customer), the transfer request including an amount of funds for transfer from the online account (customer transaction account) and identification information for a recipient of the funds, the identification information including an electronic message address associated with the recipient. (see p. 4, para. 52 – 54 and fig. 3);
- automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that

funds are ready for transfer to the recipient. (see p. 4, para. 55 and fig. 4);

- receiving a response wherein upon accepting the transfer of funds, the response includes a request by the recipient to open an account (elects to register). (see p. 4, para. 55 – 56 and fig. 4);
- opening the recipient online account for the recipient upon accepting the transfer of a gift (via registration process). (see p. 4, para. 55 – 56);
- opening/identifying the recipient online account for the recipient (“recipient account”). (see p. 4, para. 55);
- transferring said amount of funds from the first account (“customer transaction account”) to the recipient online account associated with the recipient (“recipient transaction account”). (see p. 3, para. 50);
- wherein the response (“elect[ion] to register”) includes information identifying the recipient online account. (“designate which account he or she wants to use as the recipient account”). (see p. 4, para. 55);
- wherein the electronic message address comprises an e-mail address, and wherein the electronic message is an e-mail message. (see p. 4, para. 54 – 55 and fig. 3 – 4);
- wherein the electronic message address includes a user ID associated with recipient (e-mail address), and wherein the step of automatically sending an electronic message includes initiating an e-mail session with the recipient based on the user ID. (see p. 4, para. 54 – 55); and

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- further including the step of opening ("register[ing] for the service") the first account ("customer transaction account") in response to a request from the first user to open the first account . (see p. 3, para. 50; fig. 1 and 3).

Barbara does not teach a method comprising the steps receiving a response from the recipient rejecting the transfer of funds nor sending a message to the first user notifying the user if the recipient rejects the transfer of funds; nor communicating via an instant message session.

Ewing discloses a computer implemented method transferring gifts from an online account (member profile) associated with a first user (giftor) to a recipient online account (giftee), the method (see abstract; p. 2, para. 30) comprising:

- receiving a response from the recipient (giftee) accepting or rejecting the transfer of a gift, wherein upon accepting the transfer of a gift, the response includes a request by the recipient to open an account (enter requisite information). (see p. 4, para. 48; fig. 5); and
- sending an electronic message (e-mail message) to the first user (giftor) notifying the first user (giftee) if the recipient rejects the transfer of a gift. (see p. 3, para. 39; p. 4, para. 48; fig. 5).

Examiner takes **Official Notice** that communication through an instant message session and enclosure of a URL link in an electronic message, such as an email, is old and well known in the art of online communications and computer systems.

It would have been obvious to one of ordinary skill at the time the invention was made to have modified Barbara by incorporating the acceptance or refusal methodology, as disclosed by Ewing, allowing potential recipients to accept or refuse receipt of funds. Such refusal would allow a recipient to avoid becoming beholden or otherwise intertwined with the sender of an unwanted transfer.

It would have been obvious to one of ordinary skill at the time the invention was made to have modified Barbara and Ewing by incorporating instant messaging and URL links, as is old and well known, allowing for communication through standard and conventional means in an online environment.

Regarding Claims 6 – 7, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Regarding Claim 6, Barbara fails to teach differing claim limitations from previously rejected claims, specifically Barbara fails to teach a method wherein the transfer request further includes a request for identity information; wherein the response from the recipient includes identity information and an answer to the query responsive to the request for identity confirmation; receiving from the first user an acceptance or a rejection of the identity information based on the answer to the query; and transferring funds if an acceptance of the identity is received from the first user.

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Ito discloses a method for transferring funds between a first user (remitter) and a recipient (receptor) wherein the transfer request further includes a request for identity information (an identifier); wherein the response from the recipient includes identity information (identifier) and an answer (identifier) to the query responsive to the request for identity confirmation; receiving from the first user an acceptance or a rejection of the identity information based on the answer to the query (via server's collation of identifiers); and transferring funds if an acceptance of the identity (identifier) is received from the first user (for server collation). (see col. 5, lines 12 – 57),

It would have been obvious to one of ordinary skill to have modified Barbara, Ewing and Official Notice by incorporating a security mechanism, as disclosed by Ito, ensuring that the funds transferred by the system were transferred to the correct and properly identified recipient.

Regarding Claims 23 – 25, 28 – 29, 36 – 42 and 48, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Regarding Claims 36 - 37, the differing claim limitations from previously rejected claims are taught by Barbara, specifically Barbara discloses a method of transferring funds wherein the transfer request includes a bank identifier (ABA number) that identifies a first of the plurality of affiliate banks (ABA identified bank containing source account) (see p. 2, para. 17); wherein the identified first

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affiliate bank conducts the fund transfer (see p. 2, para. 17); and wherein the settlement includes a check card (checking account) transaction and a credit card transaction. (see p. 1, para. 14).

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

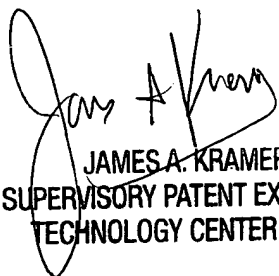
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/2/07
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